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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/239,013 01/29/99 TAKARAGI

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EXAMINER

AHMED, S

ART UNIT

PAPER NUMBER

2623

DATE MAILED:

09/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/239013

Applicant(s)

Yoichi Takaragi

Examiner

S. Ahmed

Group Art Unit

2623

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6/27/01
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 3-8, 10-15, 17-19, 21-26, 28-40 is/are pending in the application.
- Of the above claim(s) 30-40 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 3-8, 10-15, 17-19, 21-26, 28-29 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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1. The amendment filed 6/27/01 have been entered and made of record.
2. Applicant's arguments filed 6/27/01 have been fully considered but they are not persuasive with regard to claims 1, 8, 15, 19 and 26 for the following reasons:

As to claim 1, the Applicant alleges that the claimed invention is different from Funada because [Funada] “only teaches the use of a single identification information [.]” (page 9, line 5-page 10, line 12). The Applicant is respectfully reminded that the rejection of the claim(s) is a combination of two references not just Funada, references cannot be argued individually to show nonobviousness (see MPEP 2145 (d)). Funada discloses an image processing apparatus for determining the existence of a particular kinds of original images (such as securities, bank notes, confidential patterns and the like that cannot be copied) based on the color tone [first identification information relating to copyright] of each particular kind of original (col. 6, lines 17-28). Upon detection of the color tone [first identification information relating to copyright] that identifies a particular kind of original (e.g. a banknote) which should not be copied, a particular pattern [second identification information] is added to the copied document. The particular pattern [second identification information] is difficult to discriminate with human eye (col. 9, lines 25-31). The added pattern is formed with yellow toner color so as to be difficult to discriminate with human eye (col. 8, lines 30-41). The particular kind of original is scanned by a scanner, a thinned-out image signal of each of colors R, G, and B (first color signal) is used to determine whether the color tone of each pixel [first identification information relating to copyright] coincides with one of 8 tones of the particular kinds of original (col. 6, lines 29-40)

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[i.e, the color tone of each pixel (first identification information relating to copyright) of the particular kind of original is formed by a first color signal (R, G, and B signals from the scanner) which is different in color from the yellow tone of the added pattern (second identification information)]. Funada does not disclose that the first identification information is not easily recognized with the eye. Wen discloses a first identification information (Fig. 4, item 44) relating to a copyright (col. 4, lines 65-67) and not easily recognized with eye (col. 3, lines 38-40, lines 45-47).

Applicant alleges that “ Wen does not teach using two different identification codes [.]” (page 10, line 19-page 11, line 13). The Examiner disagrees. Firstly, as explained above Funada discloses using a first identification information (a color tone of a particular kind of original that should not be copied such as banknotes, i.e. a copyright code) that is formed by a scanner as R, G, and B colors to identify the particular kind of original and add a second identification information (a particular pattern such as a machine serial number) in yellow color which is different than R, G, and B. Secondly, The Applicant is respectfully reminded that claim 1 is an independent claim and the feature upon which Applicant relies [printing each code in a different color or different size on a single document] is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

RESTRICTION

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3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 3-8, 10-15, 17-19, 21-26, 28-29, drawn to an image processing apparatus comprising hiding means for forming second identification information not easily recognizable with eye and different in form from first identification information relating to a copyright and not easily recognizable with eye, classified in class 382, subclass 100.
 - II. Claims 30-40, drawn to an image processing apparatus including an input unit which inputs image data comprised of a plurality of color components, and a first identification circuit for adding first identification data to one of plurality of color components of the input image data having a first tone, classified in class 358, subclass 438.
4. The inventions are distinct, each from the other because of the following reasons:

Inventions in Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the broadest combination claim, i.e. claim 1 does not recite the elements found

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in the broadest subcombination claim, i.e. claim 30. The subcombination has separate utility such as a copying machine.

5. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Newly submitted claim 30-40 directed to an invention that is independent or distinct from the invention originally claimed for the reasons stated in para 4-5 above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 30-40 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claim 1, 3-8, 10-15, 17-19, 21-26, 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funada (U.S. patent 5,257,119) in view of Wen (U.S. patent 5,822,660). The grounds for rejections stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 1, refer to claim 2 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 8, refer to claim 9 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 15, refer to claim 16 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 19, refer to claim 20 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 25, refer to claim 26 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir Ahmed whose telephone number is (703) 305-9870. The examiner can normally be reached on Monday to Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au, can be reached on (703) 308-6604. The fax phone number for this Group is (703) 872-9314. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SA

9/07/01



SAMIR AHMED
PRIMARY EXAMINER